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| 10/047,950      | 01/15/2002  | Henry F. McIntyre    | 9D-EC-19976/064853-040 | 4820             |

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/047,950

Applicant(s)

McIntyre et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on June 13, 2005 and September 30, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 15, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 13, 2005 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the amendment and arguments filed by applicant on June 13, 2005 in reply to the previous Office action on the merits, mailed February 10, 2005, and to the election filed by applicant on September 30, 2005 in reply to the Office action setting forth a requirement for restriction, mailed September 8, 2005.

3. The amendment of claims 1, 2, 4-7, 14, 15, 17, and 19-27 by applicant in the reply filed June 13, 2005 is hereby acknowledged.

### ***Election/Restriction***

4. Applicant's election with traverse of Invention I (Claims 1-13) in the reply filed September 30, 2005 is hereby acknowledged. The traversal is on the ground(s) that the two

inventions “are not independent and distinct” because they are related, and search and examination of all inventions would not be “unduly burdensome” on the examiner.

5. Applicant’s arguments have been fully considered but are not found persuasive.
6. Regarding the argument that the inventions are not “distinct” because the two inventions are “related,” the Office action setting forth the requirement explained that the inventions are indeed “distinct,” precisely because they are “related,” and explained how and why their “relationships” caused the related inventions to be considered “distinct.” See § 5 of the Office action mailed September 8, 2005.

7. Regarding “serious burden” MPEP § 803 states, in part, under “Guidelines”:

A serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

8. As the examiner has indeed made such a *prima facie* showing of serious burden, based upon separate classification, as set forth in the requirement for restriction (Office action mailed September 8, 2005), and as applicant has offered no “showing or evidence” in rebuttal to that conclusion, simply an opinion stating a contrary position, applicant’s arguments have been dismissed as merely spurious, amounting to simply a general allegation that a serious burden would not be imposed, without specifically pointing out how the language of the claims fails to comport with the explanation of separate classification provided by the examiner.

9. The restriction requirement is still deemed proper and is therefore made FINAL.
10. Claims 14-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed September 30, 2005.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

12. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bloom (US 6,974,928).

Bloom discloses a computer-implemented method for managing electronic data over a telecommunications medium indicative of information pertaining to the transport of a product between a point of origin and a point of destination comprising the steps of: creating a plurality of data files in a database for storing respective consumer-related and product-related information; storing data indicative of consumer-related and product-related information associated with the product in a respective data file, the database accessible by a computer server system at a service center; creating an inventory record containing data indicative of a condition status of the product; storing the inventory record in a respective one of the plurality of data files; initializing a processing module stored on a portable computing device having a display screen by inputting into the portable computing device electronic data indicative of a unique customer number associated with the transport of the product between the point of origin and the point of destination, the portable computing device being capable of scanning barcodes wherein the processing module is programmed to generate a series of questions with respect to the transport of the product and display the questions on the display screen; in response to at least one of the series of questions, inputting into the portable computing device electronic data indicative of a reason code if the product is being returned from the point of destination; transmitting over the telecommunications medium to the computer server system the electronic data input into the portable computing device in response to the at least one of the series of questions; and, updating the inventory record stored in the database with the transmitted electronic data if a condition status of the product has changed.

Regarding claim 2, the method of Bloom further comprises: in response to at least one of the series of questions, inputting into the portable computing device electronic data indicative of a product type code associated with the product; and, in response to at least one of the series of questions, inputting into the portable computing device electronic data indicative of at least one code indicative of damage information associated with the product if the product is damaged.

Regarding claim 4, the method of Bloom further comprises: creating the unique customer number in response to a consumer purchasing at least one product; associating the unique customer number with a respective one of the plurality of data files containing data indicative of consumer-related and product-related information associated with the purchase of the at least one product; determining whether a delivery of the at least one product to the point of destination is a split delivery; in response to a question generated by a processing module stored on the portable computing device and displayed on the display screen, inputting into the portable computing device electronic data indicative of whether the delivery is a split delivery; and, scheduling a second delivery if the delivery is a split delivery.

13. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kantarjiev et al. (US 6,975,937).

Kantarjiev et al. disclose a computer-implemented method for managing electronic data over a telecommunications medium indicative of information pertaining to the transport of a product between a point of origin and a point of destination comprising the steps of: creating a

plurality of data files in a database for storing respective consumer-related and product-related information; storing data indicative of consumer-related and product-related information associated with the product in a respective data file, the database accessible by a computer server system at a service center; creating an inventory record containing data indicative of a condition status of the product; storing the inventory record in a respective one of the plurality of data files; initializing a processing module stored on a portable computing device having a display screen by inputting into the portable computing device electronic data indicative of a unique customer number associated with the transport of the product between the point of origin and the point of destination, the portable computing device being capable of scanning barcodes wherein the processing module is programmed to generate a series of questions with respect to the transport of the product and display the questions on the display screen; in response to at least one of the series of questions, inputting into the portable computing device electronic data indicative of a reason code if the product is being returned from the point of destination; transmitting over the telecommunications medium to the computer server system the electronic data input into the portable computing device in response to the at least one of the series of questions; and, updating the inventory record stored in the database with the transmitted electronic data if a condition status of the product has changed.

Regarding claim 2, the method of Kantarjiev et al. further comprises: in response to at least one of the series of questions, inputting into the portable computing device electronic data indicative of a product type code associated with the product; and, in response to at least one of



the series of questions, inputting into the portable computing device electronic data indicative of at least one code indicative of damage information associated with the product if the product is damaged.

Regarding claim 5, the method of Kantarjiev et al. further comprises: establishing a set of conditions for an authorized return; crediting a customer for a return of the product if the set of conditions is met; and, notifying a financial services group that a customer has been credited for the return of a product.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written description of the specification.

As described by applicant in the written specification, the instant invention is merely a method of using conventional, well known computer equipment in order to implement and effect an automated method for accomplishing the same well known results as had heretofore been

accomplished via manual means (such as those described, for example, in the Background of the Invention, on pages 1-3 of the written specification).

As such, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the conventional manual method of managing information pertaining to the transport of a product between a point of origin and a point of destination, so as to make use of well known, conventional equipment, including barcodes, barcode scanners, and various computers loaded with appropriate software, the barcode scanners and other computers being any of portable, non-portable, or handheld, in order to derive the claimed features of the instant invention, the motivation to make the modifications being simply to improve the efficiency of the information management process pertaining to the transport of a product between a point of origin and a point of destination by reducing the amount of manual effort required, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and since it has been held that simply providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

16. Claims 3 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloom (US 6,974,928).

Bloom discloses a computer-implemented method for managing electronic data over a telecommunications medium indicative of information pertaining to the transport of a product between a point of origin and a point of destination, as applied above in the rejection of claim 1

under 35 U.S.C. 102(e), but Bloom fails to specifically disclose inputting a damage code comprising a damage type, a surface type, and damage location. However, inputting a description of the damage to a delivered item being returned because of the damage is certainly a step that is well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Bloom so as to include the step of inputting a description of the damage comprising a damage code, the code comprising a damage type, a surface type, and a damage location, as is well known to do, in order to describe the damage, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Further details of the additional dependent claims would all be either inherent in the method of Bloom, or else self-evident or well known, hence obvious, to those of ordinary skill in the art, such that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have made any necessary modifications, merely as a matter of design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

17. Claims 3 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kantarjiev et al. (US 6,975,937).

Kantarjiev et al. disclose a computer-implemented method for managing electronic data over a telecommunications medium indicative of information pertaining to the transport of a

product between a point of origin and a point of destination, as applied above in the rejection of claim 1 under 35 U.S.C. 102(e), but Kantarjiev et al. fail to specifically disclose inputting a damage code comprising a damage type, a surface type, and damage location. However, inputting a description of the damage to a delivered item being returned because of the damage is certainly a step that is well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Kantarjiev et al. so as to include the step of inputting a description of the damage comprising a damage code, the code comprising a damage type, a surface type, and a damage location, as is well known to do, in order to describe the damage, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Further details of the additional dependent claims would all be either inherent in the method of Kantarjiev et al., or else self-evident or well known, hence obvious, to those of ordinary skill in the art, such that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have made any necessary modifications, merely as a matter of design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

***Response to Arguments***

18. Applicant's arguments filed June 13, 2005 have been fully considered but they are not persuasive.

19. Regarding the argument that the instant invention is not simply a computerization of an old method performed manually, as evidenced by the many disadvantages of the prior art manual method that have now been overcome by the computerization provided by the invention, even an ingenious application of known principles to known problem by use of devices already known and understood to produce predictable result does not amount to invention. Moreover, the fact that an invention may produce a more efficient and more economical method of accomplishing result does not constitute invention. *Barrott et al. v. The Drake Casket Company*, 127 USPQ 69.

Furthermore, applicant acknowledges (last paragraph of page 13 of the reply) that the various elements of computerization are all well known elements, and, notably, fails to mention any new functionality performed by the invention other than simply performing the conventional process using the well known computer elements. Note that steps such as "managing information" were indeed necessarily, thus inherently, performed by the underlying known manual method, even if such steps were not explicitly described by applicant with respect to the conventional process.

20. Regarding the argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a

sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

21. Regarding the argument that a rejection cannot be based on applicant's disclosure because such basis would comprise improper hindsight, applicant's disclosure comprises two elements: disclosure of prior art, and disclosure of the instant invention. The later of these cannot be used as a basis for the rejection, as that would indeed constitute improper hindsight. However, the former of these two elements, applicant's disclosure of the prior art known to applicant at the time of the invention, can certainly be used properly as the basis for a prior art rejection.

When applicant states that something is prior art (whether with or without any explicit statement or label as "Prior Art," it is taken as being available as prior art against the claims. Moreover, admitted prior art can indeed be used in obviousness rejections. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 610 (CCPA 1975). See MPEP § 2129.

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to the disclosure.

23. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

December 23, 2005

 12/23/05

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627